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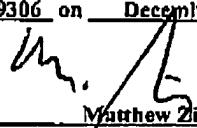
DEC 30 2004

SMART & BIGGAR

Intellectual Property & Technology Law

To Fax no.: 1-703-872-9306 438 University Avenue
Page 1 of: 10 Suite 1500, Box 111
Attention: United States Patent & Trademark Office Toronto, Canada M5G 2K8
Attention: Examiner PHAN, Joseph, T. Tel.: (416) 593-5514
Group Art Unit: 2645 Fax: (416) 591-1690
From: Matthew Zischka
Your file no.: 09/401,521 Date: December 30, 2004
Reply to Toronto file no.: 92118-11C Time:

Appellant's Reply Brief Under 37 C.F.R. 1.193 (in triplicate) in Response to an Examiner's Answer dated November 2, 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS

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In re the application of:

Charles Meubus et al.

Serial No.: 09/401,521

Filed: September 22, 1999

For: INTERNET-BASED TELEPHONE
CALL MANAGER

Group Art Unit: 2645

Examiner: Phan, Joseph, T.

Attorney Docket: 92118-11C

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APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. 1.193

The Assistant Commissioner of Patents
P.O. Box 1450
Alexandria, VA, 22313-1450
U.S.A.

Dear Sir or Madam:

The following is the Appellant's Reply Brief, submitted in triplicate and under the provisions of 37 C.F.R. 1.193(b)(1).

This Reply Brief is responsive to the Examiner's Answer, mailed November 2, 2004 (hereinafter "Examiner's Answer"). However, in this Reply Brief the Applicant does not intend to address all of the claims pending in the application nor all of the issues raised by the Examiner in the Examiner's Answer. The Appellant reasserts all submissions made in the Appeal Brief. Arguments presented in this Reply Brief are presented to further clarify the Applicant's position and to reply to the Examiner's response to arguments set out in the Examiner's Answer. The arguments are in no way intended to detract from arguments previously made by the Applicant.

Serial No.: 09/401,521
Group Art Unit: 2645

Claim Group I: Claims 21-23, 25-31 and 33-35

Appellant argues that Norris fails to disclose receiving a signaling message from a signaling network generating a response to an incoming call directed to a specified subscriber telephone line on a traffic carrying network prior to establishment of a call path for the incoming call as claimed in independent claim 21. As noted in the Appellant's Brief, Norris is replete with ambiguity as to when signaling messages are received and in fact discloses that no signaling messages appear to be received prior to the establishment of a call path on the traffic carrying network. The Examiner now interprets the phrase "prior to establishment of a call path", as claimed, as requiring a two-way voice call path (see Examiner's Answer page 14). The interpretation applied by the Examiner (i.e. importing the further limitation of the call path is a two way call path), it is respectfully submitted, is improper and beyond the plain and ordinary meaning of the claim language. In fact, Importing this further limitation into the claim is directly contrary to the guidelines set out in MPEP 2111, that "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art". Reversal of the Examiner's rejection is therefore requested.

Claim Group III: Claims 32, 36-37, 39-43, 45-48, 50-51, 53-57, and 59-61

Appellant reasserts that the Examiner has failed to establish motivation in the art to combine the teachings of Norris and Wheeler to arrive at the invention as defined in the claims of this Group. The conclusory statement by the Examiner that "It is clear that the basic concept of the applicant's invention (interacting with a call party currently connected to a data network) is taught by Norris and Wheeler's well-known AIN topology was obvious to combine with Norris' advanced and intelligent ISDN network at the time the invention was made (e.g. see Wheeler col. 8 lines 16-29)" is not sufficient to establish a *prima facie* case for obviousness. Firstly, the use of an AIN network as an ISDN network is clearly not claimed in the pending claims. Mere replacement

Serial No.: 09/401,521
Group Art Unit: 2645

of the ISDN capable network of Norris with an AIN network capable of running ISDN signaling simply would not yield the invention as claimed. Secondly, a mere observation that "one could make a modification or combination" as done by the Examiner is insufficient to establish a *prima facie* in case of obviousness. The cited art must suggest that desirability of the combination. Reversal of the Examiner's rejection of these claims is therefore requested.

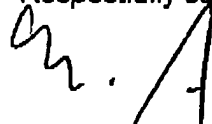
Claim Group IV: Claims 52 and 58

Appellant again reasserts that the Examiner has failed to identify each of the claimed limitations in the cited art and therefore has failed to establish a *prima facie* case of obviousness. Again, construing the clear claim language "prior to establishing a call path" as requiring a two-way call path is beyond the language of the claim and can therefore not be supported. Reversal of the rejection of claims 52 and 58 is therefore requested.

Summary

For the foregoing reasons and those set out in the Appellant's Brief, it is submitted that the Examiner's rejection of claims 21-37, 39-43, 45-48, and 50-61 is erroneous, and reversal of his rejections is respectfully requested.

Respectfully submitted,



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Registration No. 41,575

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Serial No.: 09/401,521
Group Art Unit: 2645

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Serial No.: 09/401,521
Group Art Unit: 2645

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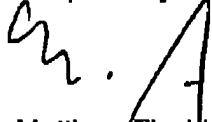
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Serial No.: 09/401,521
Group Art Unit: 2845

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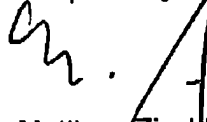
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